

REMARKS

Claims 1-53 are pending in the application. Claims 8-23 are withdrawn from consideration.

As a preliminary matter, the drawings remain objected to for not showing the “suction apparatus.” Applicants submits herewith a photocopy of the filing receipt of June 21, 2005, showing that the annotated sheet and the corrected sheet of Fig. 7 were duly submitted. A photocopy of the annotated sheet and the corrected sheet of Fig. 7 submitted on June 21, 2005, are also enclosed.

Claims 1-7 and 24-53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 6,024,019; hereinafter “Williams”) in view of Corrado et al. (U.S. Patent No. 6,196,128; hereinafter “Corrado”). Applicant submits the following in traversal of the claim rejections.

Applicant respectfully submits that claim 1 is patentable because a *prima facie* case of obviousness has not been established. Although the Examiner states that “Williams et al. teaches clearly the printing structures or the flexible plate 122, 306,” (page 4, Final Office Action) the printing member 122 or the plate material 306 does not teach, suggest, or provide motivation for the claimed flexible plate as suggested by the Examiner.

As clearly noted in Williams, the printing member 122 and the plate material 306 are the structures on which an image is recorded (col. 6, lines 46-49 (“printing structure 122 for accepting a lithographic printing pattern”; and col. 10, lines 44-46 (“[a]fter application of plate material 306 to cylinder 300 is complete, an imaging system 320 applies a lithographic image to

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the plate.”). Therefore, the structures of Williams characterized as corresponding to the claimed flexible plate are actually the structures on which images are recorded.

Claim 1, however, recites:

a flexible plate which is attached onto the fixed surface of the recording medium fixing member and whose contact surface with *the recording medium* is cleaned by the adhering roller; and

a suction apparatus for recording medium fixing which sucks air from the suction ports of the recording medium fixing member and sucks and fixes *the flexible plate* and *the recording medium* onto the fixed surface.

Unlike Williams, claim 1 recites a flexible plate and separately recites a recording medium. Therefore, the Examiner’s characterization of the printing structure 122 or the plate material 306 as corresponding to the claimed flexible plate is not supportable given that the claim separately recites a recording member that is not distinctly disclosed in Williams.

Thus, for the reasons above, claim 1 is patentable.

Claims 2-4, 52 and 53, which depend from claim 1, are patentable for at least the reasons submitted for claim 1.

In addition, claims 2 and 3 are patentable because neither Williams nor Corrado teaches, suggests or provides motivation for the adhesive strength of the adhering roller (claim 2) or for the hardness of the adhering roller (claim 3). Although the Examiner states that the claimed values would have been obvious through routine experimentation, Applicant submits that:

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re*

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Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.).

MPEP § 2144.05(II)(B). Like in *In re Antonie*, neither Williams nor Corrado recognizes any sort of adhesive strength of the adhering roller (claim 2) or for the hardness of the adhering roller (claim 3). Without such recognition, the Examiner cannot argue that adhesive strength or hardness are result-effective variables. Thus, the Examiner is not permitted to characterize the claimed adhesive strength or the hardness values as values which may be optimized through routine experimentation.

Claim 52 is also patentable because the printing structure 122 or the plate material 306 do not have a plurality of holes. Whether a printing plate having plurality of holes is well known in the art is not the relevant question here; rather, the relevant question is whether the printing structure 122 or the plate material 306 have a plurality of holes. The printing structure 122 or the plate material 306 are used to receive recording images as noted above, to suggest that the printing structure 122 or the plate material 306 would not have any holes.

For reasons similar to those submitted for claim 1, claims 5-7 are patentable.

Claims 24 and 35 remain patentable because the Examiner has failed to point out how Corrado teaches, suggests or provides motivation for the adhesive roller comprising a crown shape as claimed. The Examiner *still* has not pointed out where an adhesive roller comprising a crown shape is disclosed in Corrado.

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Claims 25-34, which depend from claim 24, are patentable for at least the reasons submitted for claim 24.

Claims 36-42, which depend from claim 35, are patentable for at least the reasons submitted for claim 35.

Claim 43 is patentable because Williams and Corrado fail to teach, suggest or provide motivation for removing foreign material on the recording medium surface in a cleaning, wherein the cleaning is firstly conducted from an almost central portion of a relative movement direction of the recording medium fixed onto the recording medium fixing member to one relative movement direction end portion, and secondly conducted from the almost central portion of the relative movement direction of the recording medium to another relative movement direction end portion.

For reasons similar to those submitted for claim 43, claims 44-45 are patentable.

Claim 45 is patentable because Corrado fails to teach, suggest or provide motivation for relatively moving the cleaning roller in a reversal direction.

Claims 46-49, which depend from claim 45, are patentable for at least the reasons submitted for claim 45.

Claim 50 is patentable for the reasons submitted for claim 43.

Claim 51, which depends from claim 50, is patentable for at least the reasons submitted for claim 50.

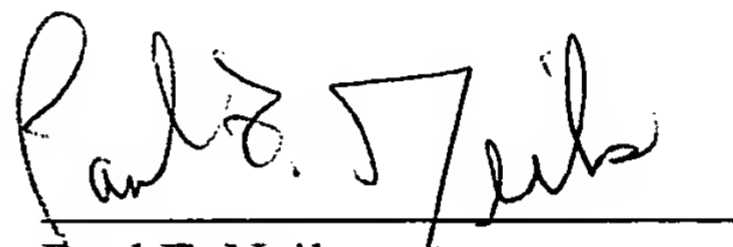
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul F. Neils", written over a horizontal line.

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23373

CUSTOMER NUMBER

Date: December 13, 2005



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FILING RECEIPT
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In re application of

Yoshiharu SASAKI

Appln. No.: 10/054,279

Confirmation No.: 6321

Filed: January 24, 2002

Group Art Unit: 2854

Examiner: Anthony H. Nguyen



For: RECORDING APPARATUS AND METHOD OF FOREIGN MATERIAL REMOVAL
THEREOF

PAPER(S) FILED ENTITLED:

1. Amendment Under 37 C.F.R. §1.111 (including Annotated Marked-Up Fig. 7 and Replacement Copy of Fig. 7).

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Date Filed: June 21, 2005

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Annotated Marked-Up Drawing

FIG.7

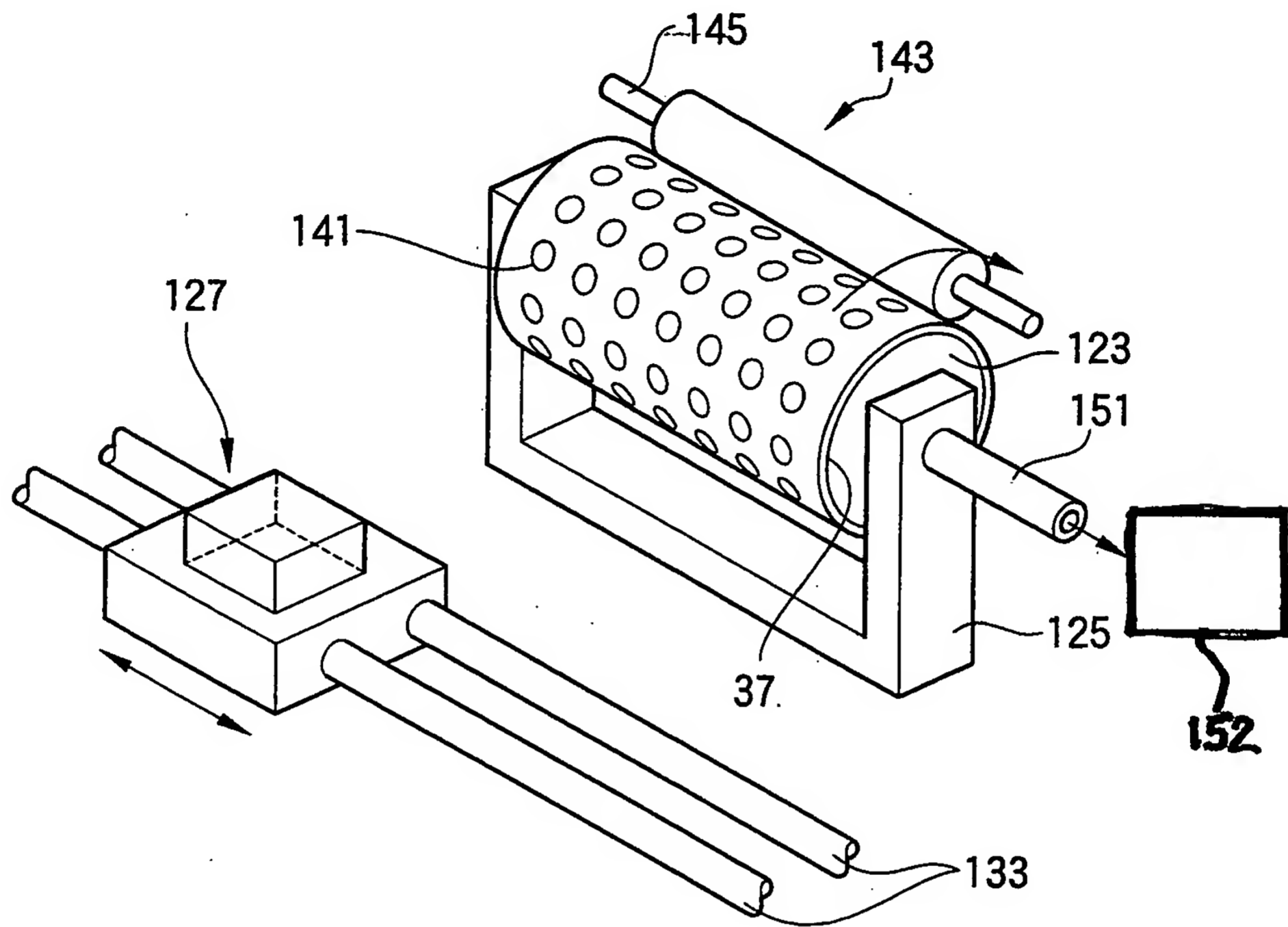


FIG.8

